

REMARKS

Claims 1-7 are pending in the application. Applicants request reconsideration in view of the remarks submitted herewith. As will be discussed in detail below, it is believed that the application is in condition for allowance.

Claims 1, 4, and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ohtani et al. (US 5,605,846) ("Ohtani"). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the * * * claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1 and 4 include the following limitation: "eliminating projections generated by said heating on said non-crystal semiconductor film using a physical elimination method." Claim 7 includes the following limitation: "wherein said non-crystal semiconductor film has a planar surface formed by eliminating, using ion beam irradiation, projections generated on said non-crystal semiconductor film due to heating of said non-crystal semiconductor film." Ohtani does not disclose either of those limitations.

The Examiner asserts that Ohtani teaches using an excimer laser to create a uniform layer; however, Ohtani only discusses making the layer more uniform in terms of its crystallinity. Column 1, lines 52-60 explains that the crystallinity of the silicon film depends on the energy of the laser and thus, it is very difficult to stably obtain a crystalline silicon film with a high reliability. As such, Ohtani is directed to an amorphous silicon film that can be uniformly crystallized with a high reliability. See Column 3, lines 55-58. There is absolutely no disclosure in Ohtani regarding eliminating projections on the semiconductor film. Indeed, there can be no disclosure of eliminating projections in Ohtani because there is no disclosure in Ohtani that projections even exist. Thus, Ohtani does not disclose, either expressly or inherently, all of the limitations of claims 1, 4, and 7. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claims 2-3 and 5-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohtani in view of Williams et al (US 6,238,582). For an obviousness rejection to be proper, the

Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1996).

Claims 2-3 and 5-6 include all of the limitations of claim 1. As discussed above, Ohtani does not teach or suggest "eliminating projections generated by said heating on said non-crystal semiconductor film using a physical elimination method." Thus, the references do not teach or suggest all of the limitations of the claims.

Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP § 2143.01. There is no teaching in the cited art to combine the references in an attempt to produce the claimed invention. As explained above, Ohtani does not disclose that projections even exist. Thus, there is no motivation for the application of ion milling of Williams after the laser annealing process in Ohtani when Ohtani is not even aware that the projections are created due to the laser annealing process. One skilled in the art would not have combined Ohtani and Williams to reach the claimed invention. Accordingly, Applicants respectfully request that the rejection be withdrawn.

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

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